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EXAMINER

LE, DAVID Q

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3621

DATE MAILED: 12/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,935

Applicant(s)

BOUET ET AL.

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

Examiner's Note

1. Examiner has pointed out particular references contained in the prior art of record in the body of this Action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 1, 15, 16** are rejected under 35 U.S.C. 102(b) as being anticipated by either Martineau or Ginter et al., US Patents 5,915,226 and 5,892,900, respectively.

As per **claim 1**:

Both Martineau and Ginter disclose

A method of distributing electronic content (Martineau: Abstract; Figs 1-3, associated description; Col 4, lines 17-38. Ginter: Abstract; Figs 1-2A, 7, 71, associated description; Col 40, line 62 – Col 42, line 3: "...support smart cards..") *between first and second terminal devices, said method comprising the steps of:*

- (a) storing the tailoring information in a memory module separate from and releasably attachable to at least the second terminal device* (see above citations);
- (b) attaching the memory module to the second terminal device* (see above citations);
- (c) while the memory module is attached to the second terminal device, reading the tailoring information from the memory module into the second terminal device* (see above citations); and
- (d) transferring electronic content from the first terminal device to the second terminal device according to the tailoring information read from the memory module into the second terminal device* (see above citations).

As per **claim 15**:

Both Martineau and Ginter disclose

A system for distributing electronic content, comprising: a wireless connection for transmission of electronic content (see above citations; Martineau: Fig 1, associated description; Ginter: Fig 7, associated description; Col 251, lines 4-6);

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an element for transferring selected electronic content over the wireless connection according to predetermined tailoring information defining electronic content eligible to be transferred from the element (see above citations);

a terminal device for receiving electronic content over the wireless connection (see above citations);

a memory module for storing the tailoring information, the memory module being separate from and releasably attachable to the terminal device (see above citations);

attaching means for attaching the memory module to the terminal device (see above citations); the terminal device being adapted to read the tailoring information from the memory module and to transmit the tailoring information to the element over the wireless connection (see above citations), and the element being adapted to transfer electronic content to the terminal device over the wireless connection according to the tailoring information (see above citations).

As per **claim 16**:

Both Martineau and Ginter (see above citations) disclose

A memory module for use with a terminal device, said memory module comprising:

a storage medium for storing tailoring information relating to specific electronic content that the memory module authorizes to be transferable to the terminal device; and an interface for mechanically and electrically coupling the memory module to the terminal device, the memory module being releasably attachable by a user to the terminal device to bring the memory module into mechanical and electrical contact with the terminal device.

4. **Claims 3, 6-9, 11-14, 17-18** are rejected under 35 U.S.C. 102(b) as being anticipated by **Ginter et al.**, US Patent No 5,892,900.

As per **claim 3**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses

..before step (d) the method further comprises the additional step of transmitting the tailoring information from the second terminal device to a third device (Ginter: see above citations; Figs 77-78, associated description) over a radio frequency link (Ginter: Col 251, lines 4-6); and

step (e) comprises transferring the electronic content to the second terminal device over the radio frequency link (see above citations).

As per **claim 6**:

Ginter discloses all the limitations of claim 3.

Ginter further discloses (Col 2: "Controlling Electronic Content"; Col 2, line 46: "...automatically enforce agreed upon rights and obligations.."). Ginter's system also has the capability to determine if data has been stored within the local memory storage and avoid having such data downloaded (see Ginter citations above).

Therefore Ginter meets all the limitations of claim 6:

automatically transferring new electronic content from the first terminal device to the second terminal device, the new electronic content fulfilling the tailoring information requirements and being determined to not have been transferred to the terminal device earlier.

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As per **claim 7**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses (see above Ginter citations; Ginter: starting at Col 8: "Electronic Content")

... the tailoring information includes time dependent subscription period information defining a time period within which electronic content may be transferred to the second terminal device.

As per **claim 8**:

Ginter discloses all the limitations of claim 7.

Ginter further discloses (see above Ginter citations)

.. the electronic content includes copies of a periodically published item.

As per **claim 9**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses (see above Ginter citations)

... the memory module is an integrated circuit card.

As per **claim 11**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses (see above Ginter citations; Ginter: starting at Col 8: "Electronic Content")

.. the electronic content is electronic goods.

As per **claim 12**:

Ginter discloses all the limitations of claim 11.

Ginter further discloses (see above Ginter citations)

.. the electronic content is at least one selected from the group consisting of movies, music, games, electronic magazines, periodicals, newspaper, and television news.

As per **claim 13**:

Ginter discloses all the limitations of claim 11.

Ginter further discloses (see above Ginter citations)

.. the electronic content includes a series of movies.

As per **claim 14**:

Ginter discloses all the limitations of claim 1.

Ginter further discloses (see above Ginter citations)

.. the electronic content is in the form of electronic services.

As per **claim 17**:

Ginter discloses all the limitations of claim 16.

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Ginter further discloses

... the memory module is an integrated circuit card (see above Ginter citations).

As per **claim 18**:

Ginter discloses all the limitations of claim 17.

Ginter further discloses (see above Ginter citations; especially Col 41, line 17: "The card can be used as an "electronic wallet" and contain electronic currency as well as credit provided by a clearinghouse.")

...the memory module comprises a storage medium for storing electronic money to be used for payment for the specific electronic content.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over ***Ginter*** as applied to claim 3 above, and further in view of ***Nokia Mobile Phones Limited (Nokia)***, International Patent Publication No WO 00/18205.

As per **claim 4**:

Ginter discloses all the limitations of claim 3.

Nokia discloses a portable communication method and system comprising a portable communications device capable of establishing a short-range, low power radio frequency (RF) link with a local terminal and causing data to be transmitted between them (Nokia: Abstract; Figs 1-3, associated description; Page 1, lines 1-24).

Therefore it would have also been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF communication method to Ginter's invention, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users. Such a method and system would meet all the limitations of claim 4, namely:

A method according to claim 3, wherein the radio frequency link is a short range communication radio frequency link.

As per **claim 5**:

Ginter in view of Nokia disclose all the limitations of claim 4.

Ginter further discloses (see above Ginter citations):

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*..sending an inquiry from the second terminal device to the third terminal device;
sending a response to the inquiry from the third terminal device to the second terminal device;
transmitting the tailoring information to the third terminal device, and
transferring the electronic content from the first terminal device to the third terminal according to
the tailoring information received from the second terminal device.*

Nokia discloses:

causing the first terminal device to enter the coverage area of the second terminal device (Nokia: Page 1, lines 21-23; Page 2, lines 4-28).

Therefore it would have also been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF communication method to Ginter's invention, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users. Such a method and system would meet all the limitations of claim 5

7. **Claim 10** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Ginter** as applied to claim 9 above, and further in view of **Martineau**.

Ginter discloses all the limitations of claim 9.

Martineau further discloses (Martineau: Col 4, lines 17-38)

*..transferring a serial number of the integrated circuit card to the first terminal device;
checking the validity of the integrated circuit card based on the serial number*

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined this authentication method as taught by Martineau into the system and method disclosed by Ginter, in order to provide a secure, portable system for delivering content over a wireless network. Such a system would have included the limitations recited above, as well as:

in response to a determination that the integrated circuit card is valid, transferring the electronic content to the second terminal device.

8. **Claims 2 and 19** are rejected under 35 U.S.C. 103(a) as being unpatentable over either Martineau or Ginter and further in view of **Nokia Mobile Phones Limited (Nokia)**, International Patent Publication No WO 00/18205.

As per **claim 2**:

Both Martineau and Ginter disclose all the limitations of claim 1.

Nokia discloses a portable communication method and system comprising a portable communications device capable of establishing a short-range, low power radio frequency (RF) link with a local terminal and causing data to be transmitted between them (Nokia: Abstract; Figs 1-3, associated description; Page 1, lines 1-24).

Nokia does not use the term "access point". However Nokia does disclose that a device within their system may be used as a wireless "gateway" for another device to access to a Public Telephone Switching Network (PTSN) (Page 5, lines 13-18, Fig 3). It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have configured any of Nokia's terminals with the

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proper software and hardware to make them into "access points", so that portable devices may access the network when coming into proximity of such devices.

Therefore it would have also been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF communication method to either Martineau's or Ginter's inventions, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users. Such a method and system would meet all the limitations of claim 2, namely:

..the memory module is releasably attachable to the first terminal device; and said method further comprises: attaching the memory module to the first terminal device;

while the memory module is attached to the first memory module, reading the tailoring information from the memory module into the first terminal device; and transferring electronic content from an access point to the first terminal device according to the tailoring information read from the memory module into the first terminal device.

As per claim 19:

Both Martineau and Ginter (see above citations; Ginter: Col 40, line 62 – Col 42, line 3: "...support smart cards..") disclose

A terminal device comprising:

a storage device for storing tailoring information relating to specific electronic content;

an interface for mechanically and electrically coupling the storage device to the terminal device, the interface allowing releasable attachment of the storage device by a user to the terminal device to bring the storage device into mechanical and electrical contact with the terminal device;

means for reading the tailoring information from the storage device into the terminal device when the storage device is in mechanical and electrical contact with the terminal device, the tailoring information defining specific electronic content that the storage device authorizes as being transferable to the terminal device;

Neither Martineau nor Ginter specifically disclose the use of a transceiver.

Nokia discloses a portable communication method and system comprising a portable communications device capable of establishing a short-range, low power radio frequency (RF) link with a local terminal and causing data to be transmitted between them, using transceivers located in each such device (Nokia: Abstract; Figs 1-3, associated description; Page 1, lines 1-24).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have applied Nokia's short range, low power RF communication method to either Martineau's or Ginter's inventions, to provide a convenient, economical, yet secure means for delivering digital content over wireless networks to authorized users. Such a method and system would meet all the limitations of claim 19, including comprising:

a transceiver for transmitting the tailoring information by wireless communication in order to authorize transfer of the specific electronic content to the terminal device.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL
December 24, 2002

John W. Hayes
John W. Hayes
Primary Examiner